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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/937,792 | 01/15/2002 | W Thomas Urmson, Jr. | 2046-011632 | 7034 |

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EXAMINER

MCANULTY, TIMOTHY P

ART UNIT

PAPER NUMBER

3682

DATE MAILED: 05/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/937,792

Applicant(s)

URMSON, JR. ET AL.

Examiner

Timothy P McAnulty

Art Unit

3682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 24-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23, 27 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 January 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5 and 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Embodiment II - Figure 7 in Paper No. 8, filed 05 March 2003 is acknowledged. The traversal is on the ground(s) that all embodiments are allowable and that there is no burden on the examiner. This is not found persuasive because indication that all embodiments are allowable is not a proper traversal of a restriction requirement and the applicant's representative is in not position to determine what is or is not a burden on the examiner.

2. However, upon reconsideration by the examiner, claims 1-8 and claims 15-22 are readable on Embodiment II - Figure 7.

The requirement is still deemed proper and is therefore made **FINAL**.

3. Claims 24-26 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Embodiment, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 8, filed 05 March 2003.

Drawings

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "48" has been used to designate both a manifold and spacers. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

5. The drawings are objected to because:

- a. the leader line for reference character R in figure 2 must be properly extended,

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- b. the leader line for reference character 69 in figure 2 must be properly extended,
- c. the leader line for reference character 56 in figure 5 must be properly extended,
- d. the leader line for reference character SL in figure 5 must be properly extended.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 4 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. Claim 4 contains the trademark/trade name Neoprene in line 2 of claim 4. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a rubber material and, accordingly, the identification/description is indefinite.

- b. The recitation of "said distribution blade" in line 2 of claim 22 lacks antecedent basis.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1,2,5,7-10,12-17,19-23,27, and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Watts.

Watts discloses in figures 1-3 an applicator bar for applying a material to a head of a rail comprising a body 3 having a flow passageway therein, said flow passageway defining an exit 5; a dam sealed by an elastomeric member 17 and said body 3; a metal distribution blade 8; and a flexible skirt 9, enclosing an upper portion of said dam. Watts further discloses in lines 10-29, a pump and reservoir in fluid communication with said flow passageway.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watts.

Watts discloses the basic apparatus as previously cited but does not disclose said dam comprising a D-shaped seal, however, forming the body of Watts to be D-shaped so as to seal said dam is one of numerous configurations a person of ordinary skill in the art would find

obvious for the purpose of sealing said dam. See *Graham v. John Deere Co.*, 38 U.S. 1, 148 USPQ 459 and *In re Dailey*, 149 USPQ 47 (CCPA 1976).

12. Claims 4, 11, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watts in view of Huck (US Patent No. 2,489,182).

Regarding claims 4 and 11, Watts discloses the basic apparatus as previously cited but does not disclose said skirt made from an elastomeric material. However, Huck teaches in figure 1 and lines 23-64 of column 3, a railway track lubricating device comprising a flexible skirt member B made from an elastomeric material. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of Watts in view of the teachings of Huck to include a skirt made from an elastomeric material to provide a skirt having increased resiliency.

Regarding claim 18, Watts discloses the basic apparatus as previously cited but does not disclose said skirt position over a portion of the upper surface of said rail. However, Huck in figure 1, teaches a railway track lubricating device comprising a flexible skirt position over a portion of the upper surface of a rail. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of Watts in view of the teachings of Huck to position said skirt over a portion of the upper surface of a rail so as to provide an increased amount of lubrication material to an upper surface of said rail.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patent documents are cited to further show the state of the art regarding rail lubricating systems:

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US Patent No. 5,641,037 to Wise et al.

US Patent No. 2,887,179 to Steele et al.


US Patent No. 1,889,313 to Graham


PCT Patent Publication WO 88/10204

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy P McAnulty whose telephone number is 703.308.8684. The examiner can normally be reached on Monday-Friday (7:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bucci can be reached on 703.308.3668. The fax phone numbers for the organization where this application or proceeding is assigned are 703.305.7687 for regular communications and 703.305.7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.308.1113.

tpm 
April 29, 2003


William C. Joyce
Patent Examiner